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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,844	08/02/2001	Hiroshi Nitta	121.1018/HEW	5683
21171 7590 06/30/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER VAN BRAMER, JOHN W	
			ART UNIT	PAPER NUMBER
			3622	
			MAIL DATE	DELIVERY MODE
			06/30/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/919,844

**Applicant(s)**

NITTA ET AL.

**Examiner**

John Van Bramer

**Art Unit**

3622

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6-9,12-15,18,19,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-9,12-15,18,19 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 28, 2008 has been entered.

### ***Election/Restrictions***

2. Newly submitted claim 23 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Independent claims 1, 7, 13, 19 and 22 are directed towards an employee communication system that stores employee information, advertising information, and wage information. The system then receives an inquiry from an employee and generates an image containing said information, and simulates purchase information. However, newly submitted claim 23 is directed towards a distinct invention in which employee information is received from a data source company and advertising information is received from an advertisement company. Then providing the employee with advertisements based upon the employee information.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claim 23 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Response to Amendment***

3. The amendment filed May 28, 2008 cancelled no claims. No claims have been amended and new Claim 23 was added. However, new claim 23 has been restricted by original presentation and as such the currently pending claims are Claims 1-3, 6-9, 12-15, 18, 19, and 22.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 6-9, 12-15, 18, 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino (U.S. Patent Number: 4,648,037) in view of Kramer et al. (U.S. Patent Number: 6,327,574).

Claim 1: Valentino discloses an information inquiry apparatus that receives an information inquiry from a terminal connected through a communication pathway, comprising:

- a. An inquiry information file that stores the inquiry information for each member of an organization (Col 5, lines 12 – 22; and Col 6, lines 49 – 68)
- b. An inquiry image display generator that generates display data from the inquiry information file so that a display image of the display data contains the inquiry information for the member of the organization. (Col 6, line 49 through Col 7, line 21)
- c. An inquiry information transmitter that receives the information inquiry from the terminal and transmits the inquiry image. (Col 6, line 49 through Col 7, line 21)
- d. A purchase simulator that simulates the member's purchase of the advertising company's product using a simulation database containing products and product prices of the advertising company. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated

with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, lines 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 2: Valentino and Kramer disclose the information inquiry apparatus in claim 1, further comprising: a confirmation information file that stores confirmation information when the employee submits the information inquiry from the terminal and receives the display image. (Valentino: Col 5, lines 49 – 64 and Col 14, lines 34 – 44)

Claim 3: Valentino and Kramer disclose the information inquiry apparatus in claim 2,

wherein the confirmation information is sent to the organization. (Valentino: Col 5, lines 49 – 64 and Col 14, lines 34 – 44)

Claim 6: Valentino and Kramer disclose the information inquiry apparatus in claim 1, wherein the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Valentino: Col 14, lines 45 – 65)

Claim 7: Valentino discloses an employee information communication method, comprising:

- a. Electronically storing employee information including at least one of employee name, employee company, employee number and employee password. (Col 5, lines 12 – 22; and Col 13, lines 52 – 67)
- b. Electronically storing employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment from a second source. (Col 13, lines 52 – 67)
- c. Receiving an inquiry from an employee. (Col 14, lines 19 – 33)
- d. Generating a detailed wage image that includes employee information and employee detailed wage information. (Col 14, lines 19 – 33)

- e. Simulating the employee's purchase of a product using a simulation database containing products and product prices of the advertising company. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted



advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 8: Valentino and Kramer disclose the employee information communication method in claim 7, further comprising electronically storing confirmation information when the employee submits the inquiry and receives the detailed wage image.  
(Valentino: Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Claim 9: Valentino and Kramer disclose the employee information communication method in claim 8, further comprising sending the confirmation information to the second source. (Valentino: Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Claim 12: Valentino and Kramer disclose the employee information communication method in claim 7, wherein the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Valentino: Col 14, lines 45 – 65)

Claim 13: Valentino discloses an employee information communication system, comprising:

- a. A first electronic data storage device that stores employee information including at least one of employee name, employee company, employee number and employee password. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- b. A third electronic data storage device that stores employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment from a second source. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- c. An image generator that receives an inquiry from an employee and generates a detailed wage image that includes employee information and employee detailed wage information. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- d. A purchase simulator that simulates the employee's purchase of a product using a simulation database containing products and product prices of the advertising company. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the

success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, lines 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 14: Valentino and Kramer disclose the employee information system in claim 13, further comprising a fourth electronic data storage device that stores confirmation information when the employee submits the inquiry and receives the detailed wage image. (Valentino: Col 5, lines 49 – 64: and Col 14, lines 34 – 44)

Claim 15: Valentino and Kramer disclose the employee information system in claim 14, wherein the confirmation information is sent to the second source. (Valentino: Col 5, lines 49 – 64: and Col 14, lines 34 – 44)

Claim 18: Valentino and Kramer disclose the employee information apparatus in claim 13, wherein the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Valentino: Col 14, lines 45 – 65)

Claim 19: Valentino discloses a wage information management apparatus, comprising:

- a. A detailed wage data structure that stores details of an employee's wage. (Col 5, line 66 through Col 6, line 10)
- b. A detailed wage inquiry authenticator that authenticates a wage inquiry based on an authentication code in the wage inquiry. (Col 6, lines 11 – 41)
- c. A communicator that, when the detailed wage authenticator authenticates the wage inquiry, sends the detailed wage data to a source of the wage inquiry. (Col 6, line 49 through Col 7, line 21)
- d. A deduction information collector that accepts a deduction information from the source of the wage inquiry. (Col 14, lines 19 – 44)

- e. A deduction information recorder that records the deduction information sent from the source of the wage inquiry. (Col 14, lines 19 – 44)
- f. A confirmation data structure that generates and stores confirmation information, to be sent to a second source, when the source submits the wage inquiry and the communicator sends the detailed wage data. (Col 5, lines 49 – 64 and Col 14, lines 19 – 44)
- g. A simulation database data structure containing products and product prices of an advertising company used for product purchase simulation. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses the generation of storage of confirmation information, he does not specifically state that the confirmation is sent to and advertiser. However, the analogous teachings of Kramer disclose advertiser's providing illuminations on structured documents. The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views (confirmations) is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 22: Valentino discloses an employee information communication apparatus, comprising:

- a. A first electronic data structure that stores employee information including at least one of employee name, employee company, employee number and employee password. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- b. A third electronic data structure that stores employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment from a second source. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- c. An image generator that receives an inquiry from an employee and generates a detailed wage image that includes employee information and employee detailed wage information. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- d. A purchase simulator that simulates the employee's purchase of a product using a simulation database containing products and product prices of the advertising company. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as

cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

***Response to Arguments***

6. Applicant's arguments filed May 28, 2008 have been fully considered but they are not persuasive.

a. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

b. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JV  
/J. V./  
Examiner, Art Unit 3622

/Eric W. Stamber/  
Supervisory Patent Examiner, Art Unit 3622